

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences



In re the Application of

James A. SATCHELL, Jr. et al.

Group Art Unit: 2121

Reissue Serial No.: 09/686,626

Examiner: S. Garland

Filed: October 12, 2000

For: VENDING MACHINE AND COMPUTER ASSEMBLY

REPLY BRIEF

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I. Introduction

This Reply Brief addresses the issues raised by the Examiner in his Answer. For purposes of clarification, the Examiner issued a first Answer, mailed April 23, 2007, setting a shortened statutory period of two (2) months, making the response date June 23, 2007.

However, on June 12, 2007, the office mailed a second Answer. The second Answer did not identify a period for response. On or about June 14, 2007, the undersigned contacted examiner Garland by telephone to inquire as to whether the Answer mailed June 12, 2007, superceded the Answer mailed April 23, 2007, to which Examiner Garland replied in the affirmative. However, when clarification was requested as to whether the period for response was set to run from the date of the June 12, 2007, mailing of the second Examiner's Answer, Examiner Garland indicated that the response date had not been reset, but continued to run from the April 23, 2007, date of the superceded Answer. Accordingly, appellants present this Reply Brief in response to issues raised in the Answer mailed June 12, 2007.

II. Response to Arguments Raised in the Answer

Appellants have been prejudiced throughout the prosecution of this application by the racial bias of non-primary Examiner Garland and his supervisor, Supervisory Primary Examiner (SPE) Leo Picard, stemming from at least as early as the conducting of a personal interview with these Examiners and one of the inventors, Mr. James A. Satchell, Jr., an African-American preacher from Tuskegee, Alabama, conducted in the presence of the undersigned and his associate, Mr. Eric Robins, on April 28, 2003. As part of the Supplemental Interview Summary Record concerning that

interview, each of Messrs. Satchell and Robins attested, under penalty of perjury, bias on the part of the Examiners. Neither Examiner's Answer makes clear that the Examiners did not even attempt to address this bias. Thus, the racial bias, which is part of the record, unrefuted by Examiners Garland and Picard.

This bias continues through the conduct of the prosecution of this application even into the Answer in this Appeal as will be detailed below.

III. Summary of the Claimed Subject Matter

Despite the issuance of not less than eight (8) office actions on the merits, the Answer under its heading "Summary of Claimed Subject Matter" alleges that "the brief is deficient because the definition of the term 'Internet' . . . has been overlooked from the explanation of independent claims 31, 97, 100, 112, 114, 127 and 133. Also the meaning of the terms of website or homepage used in independent claims 97, 100, 114, 127 and 130 should also be viewed in light of the specification"

It has been presumed that the United States Patent and Trademark Office (USPTO), in discharging its duties under 35 U.S.C. § 1, *et seq.*, shall, in its exercise of personnel decisions and management functions, have assigned examiners competent in the technological art area to which this application pertains to understand the plain meanings of terms such as webpage, homepage and the use of the Internet to access the world wide web to search such webpages and homepages.

The last non-final Office Action, mailed June 28, 2006, makes no rejection or objection of the claims under 35 U.S.C. §112, paragraphs 1 or 2. The meanings of these terms were not questioned in the Office Action from which this appeal is taken. To now, at this late date, require

appellants to now explain the basic meanings of the claim terms to the Examiner or the Board, and in the total absence of any objection or rejection based on these terms, again merely demonstrated the bias of these Examiners by increasing the burden upon these appellants, without advancing the Office's position to the Board.

The Internet has been created and maintained by thousands, if not tens of thousands, of persons skilled in the computer science, networks, routers and other such technologies. Appellants make no claim to inventing the Internet or the world wide web. Their inventive contribution however, developed at an early stage of the use of the Internet to access websites and homepages which did not exist on the then so-called "on-line" services such, as America Online (now AOL). Appellants' inventive contribution was far ahead of its time, even though today this science of the "Internet" is being introduced in grade school. Although pre-teens are not able to understand the combination of components which make up the "Internet," they are clearly educated in using the Internet as a tool for reaching websites and homepages. The effects of those many thousands of skilled computer scientists have made the use of the Internet to reach websites and homepages within the skill level of grade school children. Yet, the Office alleges it does not know what the Internet is and how you would use it to reach homepages and websites? Such a position strains credibility.

Appellants have provided contemporaneous evidence (dating from 1996) when the use of "online" services such as America Online, gave way, and were distinguished from the world wide web. See, the Evidence Appendix to the opening brief, Exhibit L to the Declaration of Satchell, Exhibit B8 "Online Superguide Battle of the Titans: Online Services vs. the Web," page 120, "The sudden popularity of the World Wide Web has galvanized online services to expand the features and improve the usability of the client software." (Continuing on page 122) "The content available to

user's of Netscape's Navigation 2.0 and of course, the entire World Wide Web, which range from the relevant to the irreverent, including sizes for virtually everything you'll find on an online service and more. The Web continues to attract new content faster than any online service"

Now, in 2007, in the Answer, the Office's position is that it does not know what the "Internet," "world wide web," "websites" or "homepages" means in the context of the claims is appalling, when such terms are well known by the grade school population of this country.

The racial bias of the examiners continue into the allegations that the summary of the claimed subject matter in the Brief is deficient because means plus function or step plus function matter is not referenced in the summary by reference to page and line of the specification and reference numeral in the drawings.

The Examiners do not even consider that such a requirement is lacking if the means plus function or step plus function is not recited in an independent claim or in any dependent claim separately argued.

The Examiners do not identify any such claim which would trigger these requirements because there are none and the appellants and the Board are forced to deal with non-material arguments which bog down and obfuscate the prosecution and the appeal process and to serve no other purpose than satisfy the racial bias of these examiners.

IV. The 35 U.S.C. §251 Statute as the Basis for the Improper Recapture of Subject Matter Surrendered in the Application

Appellants have pointed out that the Board, sitting *en banc*, has adopted Ex parte Eggert, 67 USPQ 2d 1716 (BBAI 2003) as guidance in determining whether improper recapture exists (Brief, page 9). The Answer ignores and is devoid of a response to Eggert.

Rather, the Answer relies on Pannu, 59 USPQ 1597 (Fed. Cir. 2001) and the Clement (45 USPQ 2d 1161 (Fed. Cir. 1997)) test.

Initially, appellants again point out that method claims 114-127, 129 and 130 are per se “broader” than the originally prosecuted claims as they are directed to the statutory claims of “process” (method) whereas the originally prosecuted claims of the original patent were directed to “machine” (apparatus). That one might infringe the process claim without even infringing the machine claims makes the claimed subject matter “broader” than the original patent. However, the Examiner apparently fails to comprehend that merely because the claims are “broader” than the original claims, not all “broader” claims are subject to recapture.

Initially, the Examiner overlooks or does not comprehend the second step of the Clement test which requires “to determine whether the broader aspects of the reissued claim related to surrendered subject matter.” The examiner, despite multiple requests to identify any step of claims 114-127, 129 and 130 which was surrendered during prosecution, remains mute, even in his Answer.

The Examiner merely refers to elements of the apparatus in amended claim 1, which were added for purposes of obtaining a patent on “a machine.” He does not urge that “any of the recited manipulative steps of the process” were surrendered during prosecution of the original patent. Further, despite the presence of numerous claims to a machine, he does not urge that any of such machine claims are subject to recapture under 35 U.S.C. §251.

The Examiner is quite simply befuddled by the Pannu and Clement tests, and while he may mouth the words of the test, he cannot apply it in practice.

The instant method claims are “broader” than the claims as allowed in the original patent in that patentability is not limited by the structure of the machine but, rather, hinges on the manipulative

steps of the now claimed process. This is totally ignored by the Examiner who is only fixated on the apparatus claims as allowed, and not on the manipulative steps of the claims as recited in this reissue application. Moreover, appellants do not agree that claim 114 is exemplary of all the rejected claims.

For example, claim 130 is directed to a “method of manufacturing vending machines . . .” and not at all to a method of use. Where were any manufacturing steps surrendered? The Examiner will not even address this issue. Claim 127 is directed to a method of attracting greater patronage to a vending machine. How is this recapture?

Further, the independent claims add limitations which further narrow the claim, even more so than the claims as originally allowed. Thus, even if claim 114 were to be considered “broader” in one aspect, they are “narrower” in other aspects. Thus, they also do not constitute impermissible recapture.

V. The Prior Art Sokal et al Reference and Appellants’ Rule 131 Showings

The Answer makes the following rejections against one or more claims using the Sokal et al reference.

Sokal et al in view of Bradt et al (35 U.S.C. §103(a) as to claims 31-41, 60-64, 66, 68, 69, 71-108, 110-112, 127 and 129-134).

Bradt et al in view of Sokal et al and Brown (35 U.S.C. §103(a) as to claims 65 and 70).

Bradt et al in view of Sokal et al and Small (35 U.S.C. §103(a) as to claims 67 and 113).

Bradt et al in view of Sokal et al and Brandes (35 U.S.C. §103(a) as to claim 109).

Sokal et al (35 U.S.C. §102(a) as to claim 130).

The Examiner's perceptions of conception, diligence and 131 showings are woefully inadequate.

The Examiner's position on conception and diligence in the context of a 37 C.F.R. §1.131 showing has been erratic throughout prosecution requiring appellants to submit multiple declarations from different declarants, to address the erratic prosecution of the Examiner.

Sokal et al was issued September 14, 1999, on an application filed October 10, 1995. To antedate Sokal et al, appellants must demonstrate conception prior to the filing date of Sokal coupled with diligence to an actual or constructive reduction to practice.

VI. Conception

Appellant's Evidence Appendix contains multiple declarations evidencing conception prior to the filing date of the Sokal et al reference. See, Declaration of Dora Stroud (Exhibit B2); Supplemental Declaration of Dora Stroud (Exhibit B3); Declaration of Appellants Satchell and Asamadu (Exhibit B4); and Declaration of Appellants Satchell (Exhibit B8).

As early as the Office Action of May 20, 2004 (paragraph 3), the Examiner concedes that conception was shown (a concession withdrawn in the Office Action of December 2, 2004 (paragraph 5) relying on the two centuries old non-precedential D.C. Circuit decision in Mergenthaler v. Scudder, 1897 C.D. 724. (1897)

However, having cited the controlling precedent of the Court of Customs and Patent Appeals upon the Federal Circuit in the Appeal Brief and the Examiner not contesting this authority, it appears that conception of the invention can be founded individually, or collectively, in the Exhibits B2-B4 and B8.

The Examiner's comments at page 36 of the Answer merely urge that the various dates set forth in Exhibit A to Exhibit B8 (i.e., the Satchell Declaration signed 8/10/04; not 8/20/04 as stated by the Examiner) which were corroborated by Mrs. Patricia Satchell (appellant Satchell's wife) and Kiwanis L. Satchelle (appellant Satchell's mother) and also signed by Mr. Satchell dated September 18, 1995 (just prior to the Sokal et al filing date of October 10, 1995) are, in fact, multiple dates. The fact that various of the attachments thereto have different dates, the Examiner completely ignores the fact that each of such dates are all prior to the Sokal et al filing date. Thus, on September 18, 1995, appellant Satchell, and two witnesses, confirmed that these documents were in existence and are evidence of conception.

Despite the uncontroverted statement of appellant Satchell, in paragraph 8 of Exhibit B8, that Exhibit A was sent to the Coca-Cola Company, and Coca-Cola's acknowledgment of such letter as shown in Exhibit G of the same declaration, and without alluding to any evidence or facts in his possession to the contrary, the Answer questions whether the submission was actually sent to the Coca-Cola Company. The undersigned is unaware of any other Examiner refusing to believe the factual statements made under penalty of perjury of Declarants despite his many years as an examiner and more than twenty (20) years in private practice following his government service.

As noted above, it appears that it is only appellants that have been singled out for inquisition apparently *invidious* racially discriminatory treatment. The Declarations of Dora Stroud (Exhibit B2 and B3) have not been questioned in the Answer and, of themselves, also establish conception prior to Sokal et al.

VII. Diligence1. Diligence Need Be Established Just Prior to Sokal et al to an Actual or Constructive Reduction to PracticeA. The Disputed Period of Diligence

The Office has conceded that diligence has been demonstrated from March 19, 1996 to the filing date of the application which matured into the patent being reissued. See, paragraph 12 of the Office Action dated June 28, 2006.

Thus, the Office position requires that diligence be shown from just prior to the filing date of Sokal et al (October 10, 1995) to March 18, 1996.

Appellants' position is that its predecessor application (Serial No. 08/429,583) was amended on November 8, 1995 to contain a description of the invention as now claimed and constitutes a constructive reduction to practice terminating the period of diligence.

The Answer argues (pages 38-39) that the amendment (filed November 8, 1995) constituted "new matter" in appellants parent application (Serial No. 08/429,583). Appellants are not claiming that they avoid Sokal et al based on a 35 U.S.C. § 120 benefit claim of the filing date of Serial No. 08/429,583 but, rather, that the amendment of the preceding application was achieved by a certain date and supports the reduction to practice requirement. Furthermore, there was no requirement to cancel the amended subject matter in predecessor application Serial No. 08/429,583 and the Examiner's entire argument simply lacks logical development. The public policy of the patent laws are early disclosure of inventors. Such was done here, but the Examiners continue to heap new, additional burdens, upon these appellants, to frustrate their right to obtain prompt patent protection for the invention.

The undersigned's associate, Eric P. Robins, in Exhibit B6, describes the downloading from the Public PAIR a series of documents recorded by the Office as having been received by the Office on November 8, 1995. Such documents are attached to the Robins' Declaration as Exhibits A-C and include a claim reciting internet/world wide web bringing most types of vending machines, especially soda machines into the entertainment/advertisement world (Exhibit A). A written description entitled "specification" describes the internet/world wide web connection point which permit others to access websites set up by various entities which can be accessed by the public through the doors of vending machines (pages 4 and 5(a)); and drawings disclosing, *inter alia*, Internet/www/ on a vending machine door. The Examiner disputes the date of the USPTO's own records and provides no explanation of any basis for such dispute. Again, it places upon appellants an unreasonable and almost insurmountable burden of disproving the Examiner's unsubstantiated dismissal of appellants' evidence. Thus, although appellants respectfully submit that the period of diligence extends from just prior to Sokal et al's filing date (October 10, 1995) to November 8, 1995, appellants have provided evidence of reasonable diligence not only from just prior to Sokal et al through November 8, 1995, but also through March 18, 1996.

VIII. Evidence of Diligence

The Examiner predictably disputes appellants' explanations for inactivity due to hurricane Opal which left appellant Satchell (and his family) without electricity (or water) from Thursday, October 5th to Wednesday, October 18, 1995. The Answer, page 41, disputes that the occurrence of Hurricane Opal, and the resultant damage to the electrical service causing a "black-out" in and around appellant's residence in Tuskegee, Alabama (paragraph 9 of Exhibit B-8). However,

appellant unequivocally states (Exhibit B-8, paragraph 9) that such an electrical black out occurred because of Hurricane Opal. Appellant further declared that from October 20, 1995 to November 8, 1995, he worked on a resubmission of his patent application papers (paragraph 10 of Exhibit B-8), facts that were corroborated in the declaration of Patricia Satchell, paragraph 3 (Exhibit B-5). These papers were received by the Office on November 8, 1995 (Robins Declaration, Exhibit B-6, paragraph 5 and Exhibit A thereto).

Notwithstanding the occurrence of Hurricane Opal, declarant was questioned by Examiner S. Garland as to his account of his activities on October 19, 1995, i.e., the day after electricity was restored. By declaration (Exhibit B-9, paragraph 7(B)(1) declarant Satchell stated that due to the "electrical black-out" and the attendant lack of running water, sanitation, showers, clean clothes, lights other than candles, electric appliances and other sanitary services, declarant "helped wash clothes, bathe his children, remove debris from his house and cut trees from his driveway and otherwise was 'cleaning up' after restoration of electric power. Examiner Garland's comments came after the widespread news coverage of Hurricane Katrina and its devastating effect on the affected population. To require Mr. Satchell to declare under penalty of perjury of his activities for this one day (October 19, 1995), covering his and his family's sanitary needs after two (2) weeks without electricity or sanitary services, such as running water, is an embarrassment which could only be motivated by Examiner Garland's, and his SPE Picard's, bias against Mr. Satchell.

The requirements of reasonable diligence do not require that every day be accounted for. The burden of diligence is not one of continuous uninterrupted effect, and is not to be construed according to the rules of interference. In re Eickmyer, 602 F.2d 924 (CCPA 1979). Nor need appellant account for every single day, Bey v. Kollonitsch, 231 USPQ 967, 970 (Fed. Cir. 1987),

Rines v. Morgan, 116 USPQ 145 (CCPA 1957). In fact, even in priority contests, lack of activity for 17 days constituted “reasonable diligence, Courson v. O’Conner et al., 227 F. 890 (7th Cir. 1915). See, Brief, page 15.

To all this authority, the Answer is mute, other than to reiterate the worn out position of Examiners Garland and Picard that “the entire time period from just prior to the filing date of 10/10/95 of the Sokal reference to the March 19, 1996, rejection must be accounted for by affirmative acts or acceptable excuses to overcome the Sokal reference,” citing MPEP 2138.06.

Though mouthing that they are not relying on interference practice, the Answer only cites Gunn v. Bosch, 181 USPQ 292 (sic - 181 USPQ 758) (BPI 1973) that “the activities relied upon must be directed to attaining a reduction to practice of the subject matter of the counts.” As registered practitioners and the Board readily recognize, “counts” is a term only used in interference with which Gunn is directed. Moreover, there is no statement in the Answer, or elsewhere in the record that declarants’ efforts were not directed to an actual or constructive reduction to practice. This newly minted argument is gratuitously stated in the record only as a further hurdle to appellants. Despite numerous declarations submitted as evidence, the Office waits until the Answer to raise this issue. Such should be summarily dismissed by the Board as not being timely raised in the record below.

Even if Sokal et al was available as a reference, it fails to teach the claimed subject matter and its combination with one or more secondary references does not correct this defect.

Sokal’s own teaching at column 1, lines 8-11 state that “this invention related to a method of providing communications between a plurality of individual users of stand alone terminals” . . . (emphasis added). See pag 17 of the Brief.

PC's and other computing devices existing at the time were also stand alone terminals which could be interconnected. However, none of these devices were vending machines. Where was the teaching, i.e., "spark of invention," "the motivation," or any showing that the level of ordinary skill in the art would have come up with the ideas of using vending machines as the portal to the Internet for consumers. Surely, Bradt et al, is a teaching of a vending machine, typical of many thousands of vending machines throughout the United States at that time. Why would one skilled in the art have found it obvious to modify such a vending machine to give it another purpose, e.g., to bring it into the advertising and/or entertainment arena? Let alone, where was the idea to put a consumer in contact with websites, homepages and other content via the Internet from a vending machine? However, Bradt et al had no communication device, e.g., telephone, computer, video or audio capability associated with it. It was a dumb, mute box for dispensing soda. Vending machines did not then contain consumer telephone access, consumer access to the vending machine owner/operator or any other manner of a consumer using the machine to effect a connection. It was only appellants who conceived and subsequently reduced to practice such an idea. To now look in hindsight at those who built upon appellant's invention to say it would have been anticipated or obvious recall to mind the quotation from Milton's "Paradise Lost," page 186:

"Th' invention all admir'd,^o and each, how hee
To be th' inventor miss'd, so easie it seemd
Once found, which yet unfound most would have thought
Impossible."

Even more indefensible is the use of Sokal et al alone as an anticipatory reference, e.g., against claim 130 under 35 U.S.C. §102(e).

Sokal et al is not a vending machine, has no dispensing of an article to be purchased by a consumer, and has no interactive consumer accessible internet connection system incorporated into a vending machine to permit a consumer to access websites.

The brief description of Fig. 2 (to which the examiner poses as his only teaching of a “vending machine” is made) is stated by patentee to be “Fig. 2 is an isometric view of one public access terminal of Fig. 1” (emphasis added, See, column 3, lines 1-2). No dispensing of an article to be purchased by a consumer occurs in Sokal et al.

Despite the lack of more than one limitation of the claimed invention from the teachings of Sokal et al, the examiner continues to urge that Sokal et al is a vending machine, citing the dispensing of disks (column 3, line 64 to column 4, line 5). However, as disclosed therein, the terminal of Sokal et al is for “receiving memory elements 24 (which are currently in the form of floppy disks) which can of course be inserted through a slot into the drive system” There is absolutely no disclosure therein for dispensing and/or vending items to be purchased by a consumer. Sokal et al’s terminal, known colloquially as a “Kiosk” is not a vending machine, and does not disclose “dispensing an article to be purchased by a consumer” as clearly recited in claim 130. Thus, like the PC which it is designed to duplicate, the fact that one can insert and remove a portable memory device, does not make it a vending machine because no article is being purchased by a consumer.

IX. The Kolls Reference

The supposed side by side comparison of claim 130 with Kolls on pages 34-35 of the Answer mixes the two columns, confusing what is claimed with the teachings of Kolls. The Board is

requested to disregard the Examiner's supposed comparison and instead look to Appellants' Brief, pages 20-21 as being unrefuted.

X. The Huegel and Lockwood References

Lastly, the Examiner does not know what "inherently" means. Compare his argument concerning Huegel (page 34 of the Answer) that "the remote sites of Huegel are obviously if not inherently 'websites' given the broad Internet definition set forth on page 4, lines 39-42 of the instant specification."

As claim 130 does not use the term "Internet," the Examiner's comments to the specification are a *non-sequiturs*. The Examiner, though seemingly not knowing what is meant by the term "website" in the Summary of the Invention, does not raise any question as to the meaning of "website" in claim 130. Furthermore, the fact that the remote sites of Huegel may be obvious websites clearly precludes the fact that they must be inherently websites.

The same deficiency is found in Lockwood (See, Answer, page 36). "Lockwood does not specifically mention the terminology websites . . ." (emphasis added). As with his explanation of Huegel, the Examiner continues as to Lockwood "These remote sites of Lockwood are obviously if not inherently websites . . ." (emphasis added).

As with Huegel, the Examiner's comments demonstrate that he cannot establish an anticipatory case against claim 130 on the basis of Lockwood.

Accordingly, the arguments urging anticipation of claim 130 of any of Sokal et al, Huegel or Lockwood must fail as the Examiner has not established each claimed feature either literally or inherently in the teachings of the references.

XI. Conclusion

Accordingly, refusal of all rejections is clearly warranted as they are, at best, contrived and at worst, purposely made to frustrate appellants' right to patent their pioneering invention.

Respectfully submitted,



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